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SEP 14 2007

OFFICE OF PETITIONS

In re Application of :
BRUCE CARLIN :
Application No. 10/081,841 :
Filed: 02/20/2002 :
Attorney Docket No. CAR 0002CIP :

DECISION ON PETITION

This is a decision on the petition filed March 5, 2007, to withdraw the holding of abandonment.

On April 27, 2006, the Office mailed a final Office action, which set a three-month shortened statutory period to reply. In the apparent absence of a timely filed reply, the Office mailed a Notice of Abandonment on November 14, 2006.

In the present petition, applicant averred that he filed a timely reply to the final Office action in the form of an amendment and a request for an extension of time for response within the first month, accompanied with a certificate of mailing dated August 28, 2006. Applicant requested that the Office withdraw the holding of abandonment in view of the timely submission of the reply. Furthermore, applicant asserted:

Neither Applicant's (1) mailed, nor (2) complete facsimile documents, have apparently correctly timely reached the Examiner in this application.

Applicant requests supervisory review not of the Examiner, who has evidently proceeded on what he has, but of the (apparent) clerical procedures and personnel involved in the scanning and/or movement of documents.

Applicant does not know the exact procedure as to how mailed documents are electronically scanned and entered into the PTO system, but if this is done or supposed to be done by the person also responsible for receiving and for submitting for processing Applicant's check, and if this person is identifiable, then investigation as to why Applicant's initial mailed transmittal was not scanned and entered would seemingly be warranted.

Petition, p. 3.

In response to applicant's request the Office investigated the matter and determined that applicant identified an incorrect application, No. 09/801,841, on the present petition, the amendment after final, and the request for extension of time for response within the first month, which directly resulted in the documents being scanned into an incorrect application rather than the intended and correct application, No. 10/801,841. Accordingly, the Office has located the amendment and the request for an extension of time for response within the first month filed on September 6, 2006 (certificate of mailing dated August 28, 2006), but it was not matched with the file due to the incorrect application number. The Office has transferred these documents from the incorrect application, No. 09/801,841 to the present petition. The Office advises applicant to ensure that any future communication regarding the present application clearly identify the correct application, No. 10/801,841, to avoid delay in the examination of the application.

DISCUSSION

Initially, the Office must determine whether the application is, in fact, abandoned. Namely, the Office must review the present petition to evaluate if petitioner's assertions merely involve the cause of the abandonment. Therefore, where there is no dispute as to whether an application is abandoned because no disagreement exists regarding the sufficiency of the reply or controlling dates, the filing of a petition under 37 CFR 1.181(a) to withdraw the holding of abandonment would be inappropriate. See MPEP 711.03(c)(I). Instead, a petition under 37 CFR 1.137 (accompanied by the appropriate petition fee) is necessary to revive the abandoned application. See MPEP 711.03(c)(I).

The Examiner has reviewed applicant's reply of September 6, 2006, in the form of an amendment after final. The Examiner issued an Advisory Action Before the Filing of an Appeal Brief, which is enclosed. As stated in the Advisory Action, applicant's reply filed on September 6, 2006, failed to place this application in condition for allowance.

A response to a final Office action may be entered if it places the application in condition for allowance. However, the admission or refusal to admit an amendment after a final rejection will not operate to relieve the application from its condition. Further, the entry of an amendment after a final rejection is not a matter of right.

In the present case, it is regrettable that the Office was unable to match the amendment with the application earlier, and therefore, did not mail an Advisory Action until the date of this decision. Nevertheless, it is clear from 37 CFR 1.116 that abandonment of an application is risked when an amendment is filed after a final Office action. Abandonment takes place by operation of law for failure to timely submit a proper reply to an Office action, not by the mailing of an Office communication, such an Advisory Action.¹ The mere filing of an amendment in response to a final Office action does not save the application from abandonment. Rather, the filing of a Notice of Appeal, a Request for Continued Examination accompanied by a proper submission, or a continuing application in response to a final rejection guarantees the pendency of the application.

¹ MPEP 711.03(c). See Lorenz v. Finkl, 333 F.2d 885, 889-90, 142 USPQ 26, 299-30 (CCPA 1964); Krahn v. Comm'r, 15 USPQ2d 1823, 1824 (E.D. Va. 1990); In re Application of Fischer, 6 USPQ2d 1573, 1574 (Comm'r Pat. 1984).

CONCLUSION

The application is currently abandoned due to applicant's failure to submit a proper response to the final Office action. Under the circumstances of this case, the application did not become abandoned due to a delay in reviewing the amendment or the mailing of the Advisory Action or any other error on the part of the U.S. Patent and Trademark Office. Accordingly, the petition to withdraw the holding of abandonment is dismissed. The application will remain in its abandoned state until applicant files a petition to revive the application accompanied by a proper reply and the appropriate petition fee.

ALTERNATIVE VENUE

Applicant is encouraged to consider filing a petition under 37 CFR 1.137(b) to revive an unintentionally abandoned application instead of filing a renewed petition under 37 CFR 1.181 or a petition under 37 CFR 1.137(a).

A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by:

- (1) The reply required to the outstanding final Office action in the form of **either**: (1) a Notice of Appeal (and appeal fee); (2) an amendment that *prima facie* places the application in condition for allowance; (3) a Request for Continued Examination (RCE) and submission (37 CFR 1.114), **or** (4) the filing of a continuing application under 37 CFR 1.53(b). *See MPEP 711.03(c)(III)(A)(2).*
- (2) The petition fee as set forth in 37 CFR 1.17(m),
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX: (571) 273-8300
 Attn: Office of Petitions

By hand: Customer Service Window
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

Telephone inquiries related to this decision should be directed to the undersigned at (571) 272-3211.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

Enclosure: Advisory Action

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/081,841

Applicant(s)

CARLIN, BRUCE

Examiner

Steven B. Theriault

Art Unit

2179

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 06 September 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

a. The period for reply expires 4 months from the mailing date of the final rejection.

b. The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because

(a) They raise new issues that would require further consideration and/or search (see NOTE below);

(b) They raise the issue of new matter (see NOTE below);

(c) They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

(d) They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. Applicant's reply has overcome the following rejection(s): _____.

6. Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. For purposes of appeal, the proposed amendment(s): a) will not be entered, or b) will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 20-41.

Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.

12. Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____

13. Other: _____.

/Weilun Lo/
Supervisory Patent Examiner TC
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Continuation of 11. The request for reconsideration does NOT place the application in condition for allowance because: The applicants amendment and arguments have been analyzed, considered, entered and are not persuasive for the following reasons: It is noted that the amendment filed 08/23/2006 was submitted with an improper series number and the amendment was routed improperly to the application on the submission and subsequent communications with the examiner, after the 6 moth period for reply had expired, did not contain a complete amendment (missing claims and arguments), however even if the response was considered when submitted the decision would have been as follows: In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "generating and rendering a perspective in a powerful computer such as a super computer) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In this case, the claims, state a second computer is used to generate a high quality image but do not state that a more powerful or supercomputer is required, as applicant argues (See argument page 6, middle). Moreover, the applicant argues that a camera position is not communicated in Smith (See argument page 6, top). The Examiner disagrees as it is clear from the image presented as shown in Smith that the image is shown from a particular perspective of a shelf or chair in an office setting that is rendered in 3D, which is "a" position. For example, the camera position in Smith is not shown from the bottom of a chair showing the legs only, requiring the user to pan to see the front of the chair. Nor is the positional view of the image such that the user would have to zoom in or out to see the chair. Therefore, a reasonable interpretation of the image as shown is that the image is rendered at a given camera position. Finally, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, the applicant argues that Smith does not show rendering a camera or photo realistic image. The Examiner does not debate the point, as the final office action states the Examiner relied on the combination of Smith and Technicon as shown in several pages of the final office action mailed 04/27/2006 (e.g. page 5), to teach the photorealistic image rendering in 3D. In fact, Technicon expressly states the rendering is photorealistic (See page 2, bottom). Smith suggests that other systems can perform the rendering and Technicon is an expressed example of an "other system that can render a photorealistic rendering of a 3D scene. Therefore, based on the broadest reasonable interpretation of the claims, as recited, the claims are not allowable over the final rejection.